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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,594

04/26/2006

Roxanne Costello

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EXAMINER

DEODHAR, OMKAR A

ART UNIT

PAPER NUMBER

3714

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,594	<b>Applicant(s)</b> COSTELLO ET AL.	
	<b>Examiner</b> OMKAR A. DEODHAR	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/26/06, 4/1/09, 4/24/09</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This responds to Applicant's election of Group 1, Claims 1-30, and submitted 9/20/2010.
2. Examiner notes Applicant's cancellation of Claims 31-33.
3. Claims 1-30 are consequently pending.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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**7. Claims 1-5, 9, 10, 11, 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055).**

**Regarding Claims 1, 4, 5, 10, 11, 18, 21, 23, 24:** Walker discloses an instant lottery game system and device, (Abstract, tickets for a lottery game system) which includes: a game play defining element, (Fig. 2, ticket 100 defines the game); a symbol display zone carried on the game play defining element, (Fig. 2, zone 110c contains symbols representing cards used in a poker game), a masking medium covering the symbols of the symbol display zone, (Col. 8. Lines 35-45, a scratch off latex coating covers ticket symbols of zone 110c) and a symbol interpretation zone prior to use, (Fig. 2, zone 130 shows the game outcome and is used to interpret poker hands for winning combinations of cards. Zone 130 is likewise covered with scratch off material as explained in Col. 9. Lines 8-18); and wherein the symbol interpretation zone is carried on the game play defining element, (Fig. 2, Zone 130 is carried on the ticket 100 and is thereby interpreted as "carried" on the game play defining element. Likewise, the ticket 100 is a carrier for the different game play zones -- they are printed on the ticket), the symbol interpretation zone carrying a plurality of indicia used in interpreting symbols revealed after removal of the masking medium to determine a prize outcome, (Fig. 2, Zone 130 contains indicia representing cards that form poker hands. The cards are used to interpret whether winning poker combinations are formed. The cards are thus a plurality of indicia used in interpreting existence of winning poker hands formed using scratched off symbols from zone 110c).

Walker discloses the invention substantially as claimed but since Walker's game is an implementation of video poker, Walker's symbol display zone 110c contains symbols

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representing cards used in poker and thus, Walker's symbol display zone 110c does not contain a plurality of symbols representative of a spinning reel game outcome.

However, Walker teaches that applying a slot machine theme to an instant lottery ticket game is known in the art. (Walker, Col. 1. Lines 45-50) Walker teaches that when a slot machine theme is applied to an instant lottery ticket, printed indicia would include symbols customarily used by slot machines and would also include a picture or symbol of a slot machine. (Walker, Col. 1. Lines 45-50.).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to replace poker symbols on Walker's ticket 100 with symbols on reels, representative of a spinning reel game outcome, as taught by Walker to be known in the art, for the purpose of tailoring a ticket game to a particular theme. (Walker, Col. 1. Lines 45-50.). Persons of ordinary skill in the art would realize that when the theme is video poker, game symbols would be playing cards. Likewise, persons of ordinary skill in the art would realize that when the theme is slots, game symbols would be representative of a slots game. This yields predictable results. Moreover, note that when the poker theme is replaced with a slots theme

**Note, for clarity, this modification is hereafter referred to as "Walker in view of 'Background of the Invention'".**

**Regarding Claims 2, 3, 19, 20:** Walker in view of "Background of the Invention" teaches a prize indicating zone is defined on the game play defining element and that the prize indicating zone is in the form of a paytable and contains a range of prizes which a player can possibly win in playing a game carried by the game play defining element (Fig. 2, payout zone 140 is a prize indicating zone because it indicates prizes. Payout zone 140 indicates a range of

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prizes {from \$0 to \$4} that a player can possibly win as a result of game play. It is printed on ticket 100, which is a game play defining element.)

**Regarding Claims 9, 22:** Walker in view of “Background of the Invention” teaches that recourse to the symbol interpretation zone is required to determine what prize, if any, has been won and revealing of the symbols on their own does not indicate to the player what prize, if any, has been won. (Fig. 2, recourse to zone 130 is needed to determine a type of poker hand such as a “3 of a kind.” Merely revealing symbols in zone 110c does not indicate a prize.)

**8. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Kamille (US 6,237,913.)**

**Claims 6-8:** Walker in view of “Background of the Invention” teaches the invention substantially as claimed but does not teach implementing the system in an electronic format to be played on an electronic device, such that the game play defining element is a representation of a card displayed on a screen of the electronic device and, in which the masking medium is a virtual covering layer that is “removed” by a player operating predetermined controls of the electronic device.

However, in a related invention, Kamille teaches scratch off ticket games that may be implemented in an electronic format on a electronic game device. (Kamille, Col. 5. Lines 25-42.) When Kamille's scratch off game is implemented electronically, the game ticket would be virtually displayed on a screen; thus represented as a card on a display screen. (Kamille, Col. 5. Lines 25-42.) Further, Kamille teaches that the user makes a selection thereby operating predetermined controls to virtually uncover otherwise masked elements. (Kamille, Col. 5. Lines 25-42.)

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It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to implement the scratch off ticket game taught by Walker in view of "Background of the Invention" as an electronic game on an electronic game device, as taught by Kamille, for the purpose of providing an alternate game format. Persons of ordinary skill in the art would appreciate that physical games can be played electronically and that some people may prefer to play electronically versus on an actual, physical card.

**9. Claims 12, 13, 17, 25, 26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Dietz (US 5,949,042).**

**Regarding Claims 12, 13, 25, 26:** Walker in view of "Background of the Invention" teaches the invention substantially as claimed but does not teach that the indicia of the symbol interpretation zone include operators related to spinning reel-type game operations, nor, does Walker in view of "Background of the Invention" teach that the operators vary the prizes or prizes awarded to a player so that, until the symbol interpretation zone has been referenced by the player, the player will not know what prize or prizes, if any, the player will receive.

However, in a related invention, Dietz teaches providing a symbol interpretation zone 13 on a printed lottery ticket 10. (Dietz, Fig. 1A.) Dietz's symbol interpretation zone provides a correlation between slot game outcomes and prize amount. Further, Dietz's symbol interpretation zone include certain "bonus pays" for unique combinations. Dietz's "bonus pays" are interpreted as teaching the claimed "operators" because they operate to enhance awards for unique combinations. Also, until a player references Dietz's symbol interpretation zone 13, the player will not know what prize(s), if any, the player will receive.

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It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to replace the symbol interpretation zone taught by Walker in view of "Background of the Invention" (that is, the zone defined by area 130 on ticket 100) with Dietz's symbol interpretation zone that includes bonus operators related to slot game outcomes, for the purpose of tailoring the game towards slot-reel type gaming. As pointed out above, Walker teaches that it is known in the art to tailor game tickets for gaming themes and Walker specifically discloses tailoring a game ticket to slots play. As such, if a game ticket is poised towards slot play, a person of ordinary skill in the art would appreciate that a symbol interpretation zone also be tailored towards slot play.

**Regarding Claims 17, 30:** Walker in view of "Background of the Invention" and Dietz teaches that the indicia of the symbol interpretation zone are directly related to the prizes awarded rather than the symbols of the symbol display zone, (Dietz's indicia 13 are directly related to prizes awarded rather than mere symbols. For example, Fig. 1A shows indicia directly related to a prize of \$5.00. The indicia alone are irrelevant because they do not establish a prize amount. Hence, they are interpreted as related to prizes awarded rather than merely symbols in the display zone.)

**10. Claims 14, 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Behm (US Pub. No.: 2003/0042317 A1).**

**Regarding Claims 14, 27:** Walker in view of "Background of the Invention" teaches the invention substantially as claimed but does not teach that the game play defining element includes a further, special feature zone related to a special feature, the special feature zone, initially, being covered by a masking medium.



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However, in a related invention, Behm teaches a scratch off lottery ticket 10, which is a game defining element, that includes a special feature zone 40 covered by a masking medium 22. (See Behm Fig. 1, 2A.) Behm's special feature zone 40 provides a bonus award and is separate from his main game play area 12. Thus, Behm's special feature zone 40 is a further zone, related to a special feature. A player removes the masking medium and the special feature prize is revealed.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide a special feature zone on Walker's game ticket, as taught by Behm, for the purpose of enhancing player participation, (Behm, Col. 4. Lines 22-39.)

**11. Claims 15, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Behm (US Pub. No.: 2003/0042317 A1) as applied to Claims 14 and 27, in further view of Harrison (US 5,934,671).**

**Regarding Claims 15, 28:** Walker in view of "Background of the Invention" in view of Behm teaches the invention substantially, including that a player removes masking medium of the special feature zone to determine what special prize was won, but does not teach that the player obtains access to the special feature zone only if a "Special Feature" indicium is revealed in the symbol interpretation zone.

However, in a related invention, Harrison teaches a symbol interpretation zone in which a special indicium indicates the presence of a bonus. (See Harrison, Fig. 2 and Col. 4. Lines 18-28, disclosing an indication that a symbol combination qualifies the player for a bonus.) It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify Walker's symbol interpretation zone (Walker, Fig. 2, zone 130) by providing the

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potential for a special feature indicium such that once it is revealed, a player obtains access to a special feature such as a bonus, as taught by Harrison, for the purpose of enhancing player participation. Persons of ordinary skill in the art would realize that bonus features tend to attract players and hence, making changes to present such bonus features yields the predictable results of promoting player Interest.

**12. Claims 16, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,224,055) in view of Dietz (US 5,949,042), as applied to Claims 12 and 25, in further view of Kamille (US 6,237,913.)**

**Regarding Claims 16, 29:** Walker in view of “Background of the Invention” and Dietz teaches the invention substantially as claimed but does not teach, if the spinning reel-type game has fixed pay type operators, headings associated with those operators are not covered by the masking medium with only specific operators applicable to that specific game being covered by the masking medium. However, in a related invention, Kamille teaches a lottery game ticket wherein only some regions of the ticket are coated with a scratch off (or masking) material. (See Kamille, Fig. 1, regions 101-106 are coated with scratch off material.) Other regions showing the game name and instructions are not coated with scratch off material.) Kamille thus evidences that masking some headings on a game ticket yet not masking other headings was known in the art prior to Applicant’s invention.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to cover some headings yet leave some headings uncovered in the symbol interpretation zone on the lottery ticket rendered by Walker in view of “Background of the Invention” and Dietz, as taught by Kamille, for the purpose of not unnecessarily adding to ticket

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manufacturing cost by coating areas of the game ticket that do not affect game outcome. This yields costs savings. Changes to the prior art utilizing known methods yielding predictable results are considered obvious.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sultan (US 5,887,906) teaches yet another scratch off ticket.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lewis can be reached on 571-272-7673. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Omkar Deodhar/  
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